

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

		<u>On Appeal to the Board of Appeals and Interferences</u>
Appellant(s) :	Alexander TUZHILIN et al.	Examiner: P. Winder
Serial No. :	09/013,490	Art Unit: 2155
Appeal No. :	2006-1835	
Filed :	January 26, 1998	
For :	METHOD AND APPARATUS FOR MONITOR AND NOTIFICATION IN A NETWORK	

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

On May 9, 2006, the Board of Appeals and Interferences (the "Board") issued a Decision on Appeal from the Examiner's final rejections contained in the Final Office Action issued by the U.S. Patent and Trademark Office (the "Patent Office") of claims 38, 39, 41-59 and 61-88 pending in the above-identified application. In the Decision, the Board affirmed the final rejections contained in the Final Office Action.

In accordance with 37 C.F.R. § 41.52, this Request for Rehearing (the "Request") is submitted for consideration by the Board of a possible reversal of the Decision. For the Board's convenience, the Request is being submitted in triplicate. For at least the reasons set forth below, Appellants respectfully request the Board to reconsider the Decision by reversing the final rejections of pending claims 38, 39, 41-59 and 61-88, and confirm that independent claim 86 complies with 35 U.S.C. §§ 101 and 112.

I. INTRODUCTION

On April 21, 2003, Appellants filed an Appeal Brief with the U.S. Patent and Trademark Office (the "Patent Office") appealing the final rejection of claims 38, 39, 41-59 and 61-88 contained in the Final Office Action issued by the Patent Office on November 19, 2002 in the above-identified patent application. On July 11, 2003, the Patent Office (i.e., the Examiner) issued an Examiner's Answer (the "Answer") in response to the arguments provided in the filed Appeal Brief. On September 15, 2003, Appellants filed a Reply Brief. On July 27, 2006, the Board issued the Decision affirming the Examiner final rejections of 38, 39, 41-59 and 61-88, and apparent raised issues regarding patentability of claim 86 under 35 U.S.C. §§ 101 and 112.

Appellants submit herewith the Request to (i) address the points that may have been misapprehended or overlooked by the Board, and (ii) discuss and address a reversal of the apparent new grounds of rejection. Accordingly, for the reasons presented below, it is respectfully request the Board to reverse the final rejections of claims 38, 39, 41-59 and 61-88, and reconsider of the comments regarding the relevance of claim 86 with respect to 35 U.S.C. §§ 101 and 112.

II. COMMENTS ON BOARD'S DECISION FOR ISSUES ON APPEAL

In the Decision, the Board stated that independent claim 38 is treated as the representative claim of Group I. As discussed in the Appeal and Reply Brief, independent claim 38 recites to an apparatus for monitoring information on a network which comprises, *inter alia*:

a storage device storing a predefined criterion, and having a monitoring module thereon; and

a processing device executing the monitoring module to transmit at least one instruction to the network, the at least one instruction being executed on the network and requesting a performance of a monitoring operation to monitor the information on the network as a function of the predetermined criterion, the processing device is adapted to receive data from the network based on at least one result of the monitoring operation ...

In the Decision, the Board states that U.S. Patent No. 5,809,238 issued to Greenblatt et al. (the "Greenblatt Patent") apparently discloses these recitations. (See Decision, page 6, Ins. 20-21). Then, the Board quotes from col. 6, Ins. 8-11 of the Greenblatt Patent, i.e., "DataProbe 16 communicates with networked platform P1 via transport network 12 to initiate a data collection application (resident within DataProbe 16 or on networked platform P1)" to support its statement that the "application" described in the Greenblatt Patent is a software program that includes instructions. (*Id.*, p. 7, Ins. 1-4). However, it appears that a critical feature recited in independent claim 38 has been misapprehended or overlooked by the Board, as also indicated to the Board during the oral hearing ("Hearing") by Appellants' representative for the above-identified application.

As previously indicated in the Reply Brief (p. 3) and described in detail during the Hearing, Appellants' independent claim 38 recites that the monitoring module is executed to transmit at least one instruction to the network [which is] executed on the network and requesting a performance of a monitoring operation to monitor the information on the network. This means that ***at least one executable instruction is transmitted to the network, and that such executable instruction(s) is/are executed on the network and request(s) the performance of the monitoring operation to monitor information on the network***. However, the Greenblatt Patent nowhere discloses that the instruction(s) to monitor information on the network is/are transmitted to the network with such instruction(s) being executable and monitoring information on the network.

In particular, the Greenblatt Patent specifically states that "when DataProbe is initiated or launched, the DataProbe *transfers a request initiating the operation of a data collection application on another platform*, such as a simple subroutine ... and the return of the resultant data to the DataServer platform for return to the user in the form of one or more rows of columnar data." (Greenblatt Patent, col. 5, lns. 52-62, *emphasis added*). Thus, it is clear that the DataProbe of the Greenblatt Patent transfers a request that initiates the data collection application on another platform; this means that the data collection application of the Greenblatt Patent resides on another platform, and in order to activate it, a request must be transmitted.

The Examiner and the Board apparently equate *the data collection application* of the Greenblatt Patent to **the executable instruction** as recited in independent claim 38. However, the Greenblatt Patent does not disclose that such data

collection application is being transmitted by the DataProbe, but only that a request is transmitted, to initiate the operation of such application on the different platform. Thus, in order for the Greenblatt Patent to anticipate claim 38 of the above-referenced application, it must disclose at least one of the following:

- (i) the request is executable and it is the data collection application, or
- (iii) the data collection application is transmitted by the DataProbe to such other platform.

Clearly, no such disclosure is provided in the Greenblatt Patent. The Greenblatt Patent is wholly silent as to the characteristics of the request which is used to initiate the data collection application. Indeed, it is very possible and probable that this request is a flag or a single bit memory location which may inform such further platform to execute the data collection application. Thus, in such situation, the request would not be “executable.” Indeed, there is absolutely no reason for the Greenblatt Patent to make this request executable, since its only function is to initiate the data collection application. As indicated above, at column 6, lines 8-11, the Greenblatt Patent describes that the DataProbe 16 communicates with a networked platform P1 via a transport network 12 to initiate the data collection application (resident within DataProbe 16 or on the networked platform P1) to collect the required data, e.g., which collects the requested data for networked platform P1. Again, however, the Greenblatt Patent provides **absolutely no disclosure** that the data collection application is transmitted to the networked platform.

Accordingly, not only does the Greenblatt Patent lacks any disclosure of the characteristics of the “request” and the possibility of the transmission of the data

collection application to the network, it is respectfully submitted that one having ordinary skill in the art at the time the present invention was made would likely understand that the “request” described in the Greenblatt Patent is likely only a flag which is not executable. Therefore, Appellants respectfully submit that the Greenblatt Patent does not disclose that ***at least one executable instruction is transmitted to the network, and that such executable instruction(s) is/are executed on the network and request a performance of a monitoring operation to monitor information on the network***, as recited in independent claim 38, as well as in independent claims 52, 58, 72, 78, 80, 82, 83 and 86. It appears that the Board may have inadvertently overlooked this issue in rendering its Decision. Appellants respectfully request that the Decision be reconsidered, and the final rejection of claims 38, 39, 41-59 and 61-88 be reversed.

III. **COMMENTS ON BOARD’S FURTHER STATEMENT REGARDING CLAIM 86 AND 35 U.S.C. §§ 101 AND 112**

In the Decision, the Board states that because “claim 86 fails to recite any storage medium for the claimed ‘software arrangement,’ ... this raises issues under 35 U.S.C. § 101 and 35 U.S.C. § 112 as the claim directed to disembodied software per se.” (Decision, p. 15, Ins. 3-5). Appellants respectfully disagree, and submit that claim 86 fully complies with the requirement under 35 U.S.C. §§ 101 and 112, and the relevant case law.

35 U.S.C. § 101 clearly provides that “[w]hoever invents or discovers any new and useful process machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the condition and requirements of this title.” Indeed, it has been held that inventions that encompass

algorithms and/or software are patentable subject matter under 35 U.S.C. § 101. The appropriate standard to apply for rejecting the claims of an application under 35 U.S.C. § 101 has been set forth in by the court in the *State Street* case. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) (referring to *In re Freeman*, 574 F.2d 1237 (CCPA 1978), *In re Walter*, 618 F.2d 758 (CCPA 1980), *In re Abele*, 684 F.2d 902 (CCPA 1982)).

It has been held that “[u]npatentable mathematical algorithms are identified by showing they are merely abstract ideas constituting disembodied concepts or truths that are not ‘useful.’” *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373. The *State Street* court confirmed that “the Freeman-Walter-Abele test has little, if any, applicability to determining the presence of statutory subject matter.” *Id.* at 1374. In particular, the court held that in order to comply with the requirements of 35 U.S.C. §101, the claimed invention must produce “a useful, concrete and tangible result.” *Id.* at 1373 (emphasis added). This standard has been referred to in the Manual of Patent Examining Procedure 2106(IV). The claimed inventions may contain, e.g., computer programs, methods, logic/software arrangements, etc., which produce “as a whole, a tangible, useful ... result.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1361 (Fed. Cir. 1999).

In the Decision, it appears that the Board seems to require that the software arrangement as recited in independent claim 86 needs the recitation of the “storage medium” to comply with the requirements of 35 U.S.C. §§ 101 and 112. However, no such requirements have set forth, either in these sections of U.S. Code or in the relevant case law. Indeed, there is no question that the subject matter recited in

independent claim 86 provides one or more useful, tangible or concrete results, as set forth in the *State Street* decision and other cases (e.g., see *AT&T Corp. Excel* case), as well as referenced in the Manual of Patent Examining Procedure. Thus, it is clear that the recited software arrangement of independent claim 86 is clearly within the realm patentable subject matter as authorized by of 35 U.S.C. § 101. Indeed, the U.S. Patent and Trademark Office has acknowledged this test for statutory subject matter, and confirmed that statutory subject matter is established in a claim when such claim recites “some practical application” and produces something that is concrete, tangible and useful.” (M.P.E.P. 2106(IV)(B)(1), p. 2100-12; and M.P.E.P. 2106(IV)(B)(ii), p. 2100-18). Accordingly, independent claim 86 fully complies with the standards as set forth in the *AT&T Corp.* case and M.P.E.P. 2106.

Even though independent claim 86 excludes the recitation of the storage medium, this fact should not be indicative that such claim fails the requirements of 35 U.S.C. § 101. 35 U.S.C. § 101. Indeed, while there is absolutely no statutory or case law support for a requirement of the recitation of the “storage medium, **there is clear case law that provides guidance regarding software code or software arrangements** that is likely contrary to the initial position indicated by the Board. In particular, the court in the *Eolas Technologies* case stated that “[w]ithout question, software code alone qualifies as an invention eligible under ... [35 U.S.C. § 101].” *Eolas Technologies Inc. et al. v. Microsoft Corp.*, 399 F.3d1325, 1338 (Fed. Cir. 2005). Thus, it is clear that the recited “software arrangement” of independent claim 86 is clearly within the realm of 35 U.S.C. § 101.

With respect to the possible issue of independent claim 86 with respect to 35 U.S.C. § 112, Appellants are unaware of any alleged problem that is present in this claim which may be contrary to the requirements of this section of U.S. Code. Therefore, Appellants respectfully request the Board's confirmation that independent claims 86 complies with the requirements set forth in 35 U.S.C. § 112.

IV. CONCLUSION

For at least the reasons indicated above, Appellants further respectfully request the Board to reverse the final rejection of pending claims 38, 39, 41-59 and 61-88, and confirm that independent claim 86 fully complies with 35 U.S.C. §§ 101 and 112.

Respectfully submitted,

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